

REMARKS

The Office examined claims 1-64 and rejected same. With this paper, none of the claims are amended, none are canceled, and none are added.

Claim Rejections under 35 USC §103

Claims 1-64 are rejected under 35 USC §103(a) as being unpatentable over Desai et al (U.S. Patent No. 6,820,204, Desai hereinafter) in view of Tornabene et al (U.S. Publication No. 2002/0023132, Tornabene hereinafter). Among the rejected claims, claims 22, 42 and 63 are independent.

On page 3 of the Office Action, the Examiner acknowledges that "Desai did not explicitly disclose wherein the presence information comprises one or more presence attributes, the values of the attributes indicating presence status of a user or a client of the user at the time the presence information is provided. In the same filed of endeavor Tornabene disclosed wherein the presence information comprises one or more presence attributes, the values of the attributes indicating presence status of a user or a client of the user at the time the presence information is provided (paragraphs 21 & 72)."

Applicant respectfully submits that, the present application claims priority to U.S. Provisional Applications 60/276,273, 60/276,004, 60/276,176, all filed on March 15, 2001, and 60/275,679, filed on March 14, 2001. The application of Tornabene, serial number 09/810,625, was filed on March 19, 2001, later than the 35 USC §119(e) priority dates of the present application. Therefore, the publication of Tornabene, U.S. 2002/0023132, is not by itself a valid prior art reference.

However, because the application of Tornabene claims priority to U.S. Provisional Application 60/189,973, filed on March 17, 2000, this provisional application (Tornabene Provisional hereinafter) may be used as a prior art reference under 35 USC §102(e).

Regarding applying references under 35 USC §102(e), MPEP 706.02(f)(1) states that:

The 35 USC 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective US filing date, taking into consideration any proper benefit claims to prior US applications under 35 USC 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection. (Emphasis added)

Tornabene, in this case, may be used as a prior art reference **if the Tornabene Provisional properly supports the subject matter used to make the rejection.**

The paragraphs [0021] and [0072] of Tornabene, cited by the Examiner, are quoted in their entirety as follows:

[0021] Referring to FIG. 1, a communications system 100 is capable of delivering and exchanging data between a client system 105 and a host system 110 through a communications link 115. The client system 105 typically includes one or more client devices 120 and/or client controllers 125. For example, the client system 105 may include one or more general-purpose computers (e.g., personal computers), one or more special purpose computers (e.g., devices specifically programmed to communicate with each other and/or the host system 110), or a combination of one or more general-purpose computers and one or more special-purpose computers. The client system 105 may be arranged to operate within or in concert with one or more other systems, such as for example, one or more LANs ("Local Area Networks") and/or one or more WANs ("Wide Area Networks").

[0072] The group administrator 6370 is configured to keep track of information about current group members and to provide automatically updated services to current group members. In one implementation, the group administrator 6370 includes a group member profile server 6372 configured to enter, update, retrieve, store, edit, manipulate, or otherwise process information about the current members of a group and a database 6374 for storing information associated with group members. The group administrator 6370 may be configured to gather and track information about the online status of and services provided to current group members. In one implementation, the group administrator 6370 communicates with an IM server 6902 that monitors the online status and capabilities of group members. The group administrator 6370 also may, for example, communicate with the OSP Host Complex 680 or the Internet 665 to gather and track such information.

Paragraph [0021] is essentially a general description of a communication system shown in Fig. 1 (which corresponds to Fig. 1 of Tornabene Provisional). However, neither Fig. 1 nor the paragraph [0021] discloses the claim limitation "wherein the presence information comprises one or more presence attributes, the values of the attributes indicating presence status of a user or a client of the user at the time the presence information is provided."

Paragraph [0072] is part of the description of a communication system shown in Fig. 6. It relates to elements **6370** (group administrator), **6372** (profile server), **6374** (database) and **6902** (IM server). There is no figure in Tornabene Provisional that may be reasonably construed as corresponding to the Fig. 6 of Tornabene. Apparently, Fig. 6 was added at the time the Tornabene regular application was filed on March 19, 2001, i.e. after Applicant's priority dates of March 14-15, 2001.

The Tornabene Provisional discloses a subscriber profile server **530**, a database **528** and an IM server **516** in Fig. 5, which is similar to Fig. 5 of Tornabene. The functions of the subscriber profile server **530** and the database **528** are described as follows:

In the implementation of Fig. 5, the IM host complex 512 also includes a database 528 for storing large amounts of subscriber profile data and a subscriber profile server 530 for entering, retrieving, editing, manipulating, or otherwise processing such subscriber profile data. In one implementation, a subscriber's profile data including, for example, the subscriber's buddy list, alert preferences, designated stocks, identified interests, and geographic location, may be maintained in the database 528. The subscriber may enter, edit and/or delete profile data using an installed IM client application on the client system 502 to interact with the subscriber profile server 530 (page 13, lines 14-21).

There is no disclosure in the Tornabene Provisional regarding the group administrator **6370**. Therefore, the functions of the group administrator **6370** as disclosed in Tornabene, i.e. keep tracking of information about current group members, providing automatically updated services to current group members, gathering and tracking information about the online status of and services provided to current group members, communicating with an IM server **6902** that monitors the online status and capabilities of group members, are not disclosed in the Tornabene Provisional.

Clearly, the above functions of the group administrator **6370** are relied upon by the Examiner in rejecting the claim limitation "wherein the presence information comprises one or more presence attributes, the values of the attributes indicating presence status of a user or a client of the user at the time the presence information is provided." However, the subject matter used to make the rejection is not properly supported by the Tornabene Provisional.

Based on the above, the rejection of claims 1-64 under 35 USC §103(a) over Desai in view of Tornabene is not correct. Applicant respectfully requests the rejection be reconsidered and withdrawn.

### Conclusion

For all the foregoing reasons, it is believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited. Applicant urges the Examiner to call the undersigned agent to discuss the present response if there are any questions.

Respectfully submitted,



Shiming Wu  
Attorney for the Applicant  
Registration No. 56,885

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WARE, FRESSOLA, VAN DER SLUYS  
& ADOLPHSON LLP  
755 Main Street, P.O. Box 224  
Monroe, Connecticut 06468  
Tel: (203) 261-1234